

## REMARKS

Rejection of Claim 30 Under 35 U.S.C. § 112

The Examiner has rejected claim 30 under 35 U.S.C. § 112, second paragraph, as indefinite. The Applicant has amended claim 30 to overcome this rejection. The Applicant respectfully submits that the amendment to lines 12 and 17 of claim 30 overcome the Examiner's rejection under 35 U.S.C. § 112. Accordingly, the Applicant respectfully requests withdrawal of this rejection.

Rejection of Claim 30 Under 35 U.S.C. § 102(e)

The Examiner has rejected claim 30 under 35 U.S.C. § 102(e) as anticipated by U.S. patent number 6,650,431 issued to Roberts et al, hereinafter referred to as Roberts. The Applicant does not admit that Roberts is indeed prior art and preserves the option to antedate this reference asserted by the Examiner to be prior art. The Applicant respectfully requests careful reconsideration of the arguments provided below that support traversal of the rejection of the amended claim 30 under 35 U.S.C § 102(e).

Claim 30 includes limitations of "selecting a first imaging related option to form images on the media using **multiple** of the plurality of pages of data **on individual** of the media". (emphasis added) The Applicant respectfully contends that Roberts does not teach or suggest this limitation. In page 3, item 6 of the office action response, the Examiner states that "Roberts discloses a method for forming images on media using a plurality of pages of data (column 6, lines 40-48), comprising selecting a first imaging related option (black and white or monochromatic) (column 9, lines 16-33) to form images on the media **using N** of the plurality of pages of data on individual pages of the data (which reads on printing a page of the document (**assuming that N=1**) (column 6, lines 49-55)". (emphasis added) The Applicant has amended claim 30 to recite "multiple" instead of "N".

The Applicant believes that the cited sections of Roberts do not disclose forming "images on the media using **multiple** of the plurality of pages of data **on individual of the media**". (emphasis added) According to a definition in the Webster's Ninth New Collegiate Dictionary "multiple" refers to "consisting of, including, or involving **more than one**" (emphasis added) But the Examiner has asserted that Roberts anticipates the amended claim 30 based upon "assuming that N=1". But, the amended claim 30 no

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longer recites the limitation of "N". Rather, "N" has been replaced by "multiple", which as indicated by the definition of "multiple", cannot equal one. The Applicant respectfully contends that column 6, lines 49-55 of Roberts does not disclose that the limitation of the amended claim 30 "to form images on the media ***using multiple of the plurality of pages of data on individual of the media.***" (emphasis added)

Therefore, because the amended claim 30 includes limitations not taught or suggested in Roberts, the Applicant respectfully contends that a valid anticipation rejection of the amended claim 30 is not present for at least this reason. Accordingly, the Applicant respectfully requests withdrawal of the rejection of claim 30, as amended, under 35 U.S.C. § 102(e) as anticipated by Roberts.

**Rejections of Claims 33-35 Under 35 U.S.C. § 102(e)**

The Examiner has rejected claims 33-35 under 35 U.S.C. 102(e) as anticipated by United States patent number 5,978,557 issued to Kato, hereinafter referred to as Kato. The Applicant does not admit that Kato is indeed prior art and preserves the option to antedate this reference asserted by the Examiner to be prior art. The Applicant respectfully requests careful reconsideration of the arguments provided below that support traversal of the rejection of claims 33-35 under 35 U.S.C § 102(e).

Claim 33 includes the limitations of "***including blank units*** of the media, corresponding to the ones of the plurality of pages of data having the second characteristic, ***among units of the media having the images corresponding to the first characteristic*** according to the order" and "***forming the images on the blank units of the media***, corresponding to the ones of the plurality of pages of data ***having the second characteristic***, using the second imaging device" (emphasis added) The Applicant respectfully contends that the sections of Kato cited by the Examiner in this office action do not teach or suggest these limitations of claim 33.

On page 5, item 8, of the Examiner's office action it is asserted that Kato discloses "sending the plural pages to . . . ***including blank pages (replacement pages)*** corresponding to the ones of the plural pages (column 5, line 4 to column 6, line 59, column 7, lines 11-17, and column 9, line 52 to column 10, line 4)" and it is asserted that Kato discloses "forming images ***on the blank units*** of the media using the second imaging device (column 2, lines 11-17 and column 9, line 52 to column 10, line 4)".

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(emphasis added) But, for example, Kato, at column 2, lines 11-17 discloses, "The second sending means may send the data of one page which is sent to a printing device which is not set by the second setting means to the printing device set by the second setting means. With this arrangement, ***a printing device prints all pages while the other printing device prints only replacement pages.*** Although the output forms are different, pages to be replaced are obvious." (emphasis added)

And, Kato at column 5, lines 15-30 further discloses "[w]hen the client instructs printing for a document of 10 pages (the entire document does not always consist of 10 pages), and the third and fifth pages require color printing, print data of the third and fifth pages are sent to the local printer 11a, and print data of the remaining pages are sent to the server 20. As a result, ***the third and fifth pages are printed and output from the local printer 11a while the remaining first, second, fourth and sixth to tenth pages are printed by the LBP 21.*** Since one document is printed by two printers, the positions where the color pages are to be inserted in the monochromatic pages are clearly indicated. Sometimes the number of monochromatic pages may be smaller. Therefore, dummy pages (***replacement pages***) ***with a predetermined message*** indicating the insertion positions are printed on the monochromatic or color printing side." (emphasis added)

These sections of Kato appear to teach that some pages are printed by local printer 11a and some pages are printed by LBP 21, with "dummy pages (replacement pages) ***with a predetermined message indicating the insertion positions*** are printed on the monochromatic or color printing side." So, the "replacement pages" disclosed by Kato ***are different*** from the "third and fifth pages" and the "remaining first, second, fourth, and sixth to tenth pages". That is, Kato does not appear to teach that the "color pages" or the "monochromatic pages" are printed on the "(replacement pages) with a predetermined message". Rather, the "replacement pages" seem to serve to indicate "the insertion positions" and the "color pages" or "monochromatic pages" are printed on something other than the "replacement pages". But, the Examiner seems to be asserting, from item 8 on page 5, that "the blank units of the media" reads upon the "dummy pages (replacement pages)". However, claim 33 recites "forming the images ***on the blank units*** of the media, corresponding to the ones of the plurality of pages of data of data

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having the second characteristic, using the second imaging device" (emphasis added). This is not what Kato teaches.

For at least this reason, the Applicant respectfully contends that Kato does not teach or suggest all the limitations of claim 33. Therefore, for at least the reason that the cited section of Kato does not teach these limitations of claim 33, claim 33 is not anticipated by Kato. Additionally, because claims 34 and 35 incorporate by reference the limitations of claim 33, claims 34 and 35 are not anticipated by Kato. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 33-35 under 35 U.S.C. § 102(e).

From the associations put forth by the Examiner on page 5, item 8, of the office action, the Examiner seems to be asserting that "the blank units of the media" reads upon the "replacement pages" of Kato (item 7, page 5 of the Examiner's office action). But Kato teaches that the "replacement pages do not contain document data" (item 7, page 5 of the Examiner's office action). In contrast, claim 33 recites "forming images on the blank units of the media", where these "blank units of the media" were included "among units of the media having the images corresponding to the first characteristic." However, Kato teaches that "dummy pages (replacement pages) with a predetermined message indicating the insertion positions" (which, as asserted by the Examiner, are supposed to be read upon by "blank units of the media") are printed. But, "blank" in this context, as defined by Webster's Ninth New Collegiate Dictionary, refers to "free from writing or marks". Therefore, "dummy pages (replacement pages) with a predetermined message indicating the insertion positions" cannot be "**blank** units of the media". (emphasis added) So, these limitations claim 33 are not disclosed in Kato.

Therefore, for at least the reason that the cited section of Kato does not teach these limitations of claim 33, claim 33 is not anticipated by Kato. Additionally, because claims 34 and 35 incorporate by reference the limitations of claim 33, claims 34 and 35 are not anticipated by Kato. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 33-35 under 35 U.S.C. § 102(e).

#### Conclusion

The Applicant respectfully contends that the subject application is in a condition for allowance. Accordingly, allowance is respectfully request.

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Respectfully submitted,

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